

Appl. No. 10/028,748
Amdt. dated May 16, 2003
Reply to Office Action of January 16, 2003

PATENT

REMARKS/ARGUMENTS

The present amendment is submitted in accordance with the Revised Amendment Format as set forth in the Notice provided on the USPTO web site for the Office of Patent Legal Administration; Pre-OG Notices; signed 1/31/03.

Priority

In response to the Examiner's suggestion, Applicants have amended the specification to update the status of U.S. Application Serial No. 09/020,743, which is a parent application of the above identified application.

Specification

In response to the Examiner's suggestion, Applications have amended the title without acquiescing to any ground of objections.

Double Patenting

Claims 1-48 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,420,108. U.S. Patent No. 6,420,108 was issued from U.S. Application Serial No. 09/020,743, and the above identified application is a continuation application of the same U.S. Application Serial No. 09/020,743. As suggested by the Examiner, these rejections can be overcome by filing a terminal disclaimer. In response, applicants will file a terminal disclaimer when other issues of patentability related to the above identified application are resolved.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. In response, Applicants have amended or canceled some

claims without acquiescing any grounds of rejections. Therefore the above rejections should be withdrawn.

Claim Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1-5, 20, 21 & 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhao et al. Claims 25-29, 44, 45, 47 & 48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zhao et al. Claim 19 & 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. Claims 6-18 & 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al in view of Zhao et al. Claims 22, 24 & 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al in view of Beattie.

In response to these rejections, Applicants has amended or canceled some claims. The amended independent claims 1 and 25 recite, among others, processes or instructions for obtaining information associated with a first expressed sequence and associating a first displayed mark with the obtained information associated with the first expressed sequence. In contrast, Zhao discloses a method for analyzing large numbers of cDNA plasmids from brain tissue. The Zhao method includes preparing a filter using cDNA plasmids isolated from a brain tissue sample. Zhao purified the plasmids and grided them onto a nylon membrane filter using a robot. Then, Zhao constructed probes on the filter from purified poly(A)+ RNA, again from brain tissue. Zhao then hybridized tissue samples with the filter. Then, using a Bioimaging Analyzer and an automatic quantification program, Zhao analyzed the amount of radioactivity existing at each of the probes and performed a data analysis as illustrated by a series of graphs in Fig. 3, page 211. Finally, Zhao performed sequence analysis for clones of interest. Thus, at the time of producing the graph, Zhao did not know the sequence or other characteristics of the cDNA sequences used as probes. It is after he has displayed expression levels in the graph that he proposes to conduct experiments to determine the sequence of particular probes.

Therefore Zhao, alone or in combination with other references, does not disclose, teach, or suggest the processes or instructions for obtaining information associated with a first expressed sequence and associating a first displayed mark with the obtained information, as

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recited in independent claims 1 and 25 and their dependent claims. Therefore the rejections under 35 U.S.C. §§ 102 and 103 have been overcome.

Other Issues

On Information Disclosure Statements Paper Nos. 1 and 6, the Examiner indicated "date considered" to be "1/12/03," but did not initial any references on at least two pages of the Information Disclosure Statements. Applicants respectively request the Examiner initial these references considered by the Examiner so that a clear record of prosecution history may be maintained.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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